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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,108	01/08/2001	Jorg Bruss	027559-039	5345

27045 7590 12/27/2004

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EXAMINER

NGUYEN, TU X

ART UNIT PAPER NUMBER

2684

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/755,108	Applicant(s) BRUSS, JORG	
	Examiner Tu X Nguyen	Art Unit 2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 17-19 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 and 20-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-19 and 33-35 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's arguments filed 9/1/04 have been fully considered but they are not persuasive.

Regarding claim 1, applicants argue that "The reference cited by the examiner is reproduced below: The bearer Limiting factor associated with terminal devices are- , for example, introduced by the involved protocols, bandwidth restrictions on the involved interfaces, user settings, operator settings, etc. (Specification, 7age 5, lines 3-6). Thus, it appears that the examiner may be interpreting this passage to mean the bearer limiting factors as- defined to be the involved protocols. bandwidth restrictions on the involved interfaces. user settings, operator settings, etc. However. This limitation is contrary to the plain language of the sentence. The sentence states that bearer limiting factors are introduced by the involved protocols, bandwidth restrictions on the involved interfaces, user settings, operator settings, etc. The sentence does not define the bearer limiting factors. As indicated by the plain language of the sentence. the sentence only indicates the source of the bearer Limiting factors. but not the factors themselves". The Examiner agrees with the applicant argument such as "The sentence states that bearer limiting factors are introduced by the involved protocols, bandwidth restrictions on the involved interfaces, user settings, operator settings, etc. The sentence does not define the bearer limiting factors. As indicated by the plain language of the sentence. the sentence only indicates the source of the bearer Limiting factors". However, it is noted that the features upon which applicant relies (i.e., The sentence states that bearer

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limiting factors are introduced by the involved protocols, bandwidth restrictions on the involved interfaces, user settings, operator settings, etc.") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, Lopez-torries discloses "dialog call and bearer capability...the Characteristics presented mobile bearer capability compatibility information include as transfer mode, transfer rate, etc." (see col.17 lines 20-50) reads on "bearer limit information" with reasonable broadest interpretation.

Applicant's argument that "also appears that the examiner is still maintaining that the term "mapping" is identical to the term 'calculating" (Office Action, page 4, line 10). The examiner justifies his argument by stating that features upon which the Applicant relies are not recited within the rejected claims. However, it appears that the examiner may have misread the Applicant's previous arguments. In contrast to the examiner's interpretation of the Applicant's argument. the Applicant is not relying on the specification for a definition of a term. The Applicant is only relying on the plain wording of the claim element of calculating, in said network, multicall limit information based on capability bearer limit information associated with said user equipment and multicall Information associated with said network". However the Applicant has helped to point out "calculating" is interpreted as "The visitor location register VLR to dynamically store information about mobile subscribers, for example the location area where the subscriber is located or is roaming. The VLR also contains information to handle mobile originating and terminating calls. A base station controller BSC is a node that controls

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various base transceiver stations BTS and performs radio network management. The base transceiver station BTS is the node that handles the radio traffic in any one cell to the mobiles stations MS1, MS2, . . . Msn via an air- Interface, i.e. communication channel or traffic channel CCI. Such an interconnection of HLR, VLR, MSC and a base station system is also disclosed". Therefore, The base station performs radio network management, handles the radio traffic, communication channel or traffic channel, call set up : establishment, configuration, transfer mode, etc., Those functions are being "calculated" by base station.

Regarding claim 3, applicants argue" As the examiner should be aware, claim language using terms of degree is perfectly acceptable - even though me language may not be precise, Seattle Box Co., v. Industrial Crating & Packing, Inc.. 731 F,2d B1e, 221 USPQ 568. (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. MPEP 2173.05(b). Although the examiner is free to interpret the claim elements in a broad manner, the Applicant is aware of no rule that forces the Applicant to "clarify a specific number or some kind of comparison in term of maximum. In fact, the Applicant is not aware of any rule that justifies the examiner's interpretation of the plain meaning of the claim. Therefore, the Applicant respectfully request that the examiner provide specific authority explaining how and why he believes he can impose his own definition to reinterpret the elements of the claims". The examiner agrees applicants argument "language using terms of degree is perfectly acceptable - even though me language may not be precise... Acceptability of the claim language depends

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on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. Although the examiner is free to interpret the claim elements in a broad manner". Therefore, Lopez-Torres disclose "the number of traffic channels required by the multi-dialogue" (see col.17 lines 34-35), "the MSC/VLR receives a multi-dialogue request which contains a number of sets of bearer capabilities" (see col.13 lines 40-41) reads on "maximum"/ "largest" (see Applicant's new claim 35) with reasonable broadest interpretation.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-10, 12-13, 17-19 and 33-35, are rejected under 35 U.S.C. 102(e) as being anticipated by Lopez Torres (US Patent 6,144,647).

Regarding claim 1, Lopez Torres discloses a method for exchanging multical capabilities between user equipment and a network in a radio communication system comprising the steps of:

receiving, from said user equipment to said network, bearer limit information associated with said user equipment (see col.17 lines 20-50);

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calculating (see col.2 lines 45-57), in said network, multical limit information based on said bearer limit information associated with said user equipment and multical information associated with said network (see col.10 lines 40-54); and

returning, to said user equipment, said multical information (see col.17 lines 50-61).

Regarding claim 2, Lopez Torres discloses said network includes a mobile switching center and a radio network controller, each of which perform functions associated with radiocommunication support of said user equipment (see col.2 lines 27-57), said method further comprising the steps of:

determining bearer limit information associated with said RNC (see col.2 lines 45-57, "BSC" corresponds to "RNC"); and

Using said bearer limit information associated with said RNC to calculate said multical limit information (see col.17 lines 1-67).

Regarding claims 3 and 19, Lopez Torres discloses receiving an indication of a maximum number of bearers supported by said user terminal (see col.12 lines 16-25), "number of sets of bearer capabilities" reads on "maximum number".

Regarding claim 4, Lopez Torres discloses receiving a value associated with at least one parameter from which a maximum number of bearers supported by said user terminal can be determined (see col.16-17).

Regarding claims 5 and 8, Lopez Torres discloses transmitting said bearer limit information associated with said RNC for storage in an RNC limits storage unit (see col.2 lines 26-67).

Regarding claim 6, Lopez Torres discloses said RNC storage unit is collocated with said MSC (see fig.2).

Regarding claim 7, Lopez Torres discloses storing said multical limit information in a storage unit within said user equipment (see col.15 lines 24 through col.16 line 25). It is inherently that the mobile station comprising storing unit in order transmit and negotiating to network of its mobile identification service and mobile bearer capability information.

Regarding claims 9-10 and 12-13, Lopez Torres discloses receiving said bearer limit information after the transmission of a location updating request message (see col.2 lines 31-42).

Regarding claims 17-18, Lopez Torres discloses everything as claim 1 above. More specifically, Lopez Torres discloses "determining a change in said multical capabilities has occurred in said user equipment" (see col.17 lines 50-60), "negotiation number of mobile bearer capabilities" reads on "change".

Regarding claim 33, Lopez Torres discloses a computer program in a node of a radiocommunication system (see col.2 lines 42-43).

Regarding claim 34, Lopez Torres disclose a computer program in user equipment (see col.17 lines 50-60 and col.13 lines 1-5). It is inherently the mobile station is computer program in capable functions such as simultaneously transfer data and speech.

Regarding claim 35, Lopes-Torres disclose everything as claim 1 above. More specifically, Lopes-Torres disclose the largest number of bearers for the involved

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entities, using the limit information of the sewing network entity, the limit information of the involved radio access network entity stored in the serving network storage unit and the limit information provided by the user equipment (see col.2 lines 45-50 and col.13 lines 39-50).

Allowable Subject Matter

4. Claim 11, objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

Regarding claim 11, the prior arts fail to teach "said bearer limit information is included as an extension of a CLASSMARK 2 information element in said location updating request message" as cited in the claim.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Nguyen whose telephone number is 703-305-

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3427. The examiner can normally be reached on Monday through Friday from 8:30AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MAUNG NAY A, can be reached at (703) 308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

TP
December 2, 2004


NAY MAUNG
SUPERVISORY PATENT EXAMINER